

REMARKS

Claims 1-19 are pending in the present application.

At the outset, Applicants wish to thank Examiner Yeung for the helpful and courteous discussion with their undersigned Representative on May 4, 2004. During this discussion, the Examiner agreed to provide an English translation of Kobayashi et al (JP 3-195465).

Applicants have received this translation and thank the Examiner for providing the same.

Reconsideration is respectfully requested in view of the amendments and remarks set forth herein.

The rejections of: (a) Claims 1-5, 7-10, and 15-18 under 35 U.S.C. §102(b) over Kobayashi et al; (b) Claims 6, 11, 12, and 19 under 35 U.S.C. §103(a) over Kobayashi et al; and Claims 13 and 14 under 35 U.S.C. §103(a) over Kobayashi et al in view of Miyagawa et al, are obviated by amendment.

The presently claimed invention provides a method of preparing cooked rice, comprising steaming raw rice having a water content of less than 30 % by weight and then boiling the steamed rice with the proviso that the raw rice is not soaked in water prior to said steaming (Claim 1). In the present specification the meaning of “soaked” can be understood by reference to the definition of “soaking process” which means “a process of soaking raw rice in water or warm water for one to 2 hours to allow the raw rice to absorb water sufficiently to a final water content of 30 to 36 % by weight” (see page 5, lines 16-18).

Kobayashi et al discloses a process for cooking rice by *soaking rice in water*, steaming the soaked rice, and then cooking the steamed rice with hot water (see “Means for solving the problems,” English translation, page 3, lines 14-25). Applicants note that the

proviso of the claimed invention distinguishes the claimed invention from this disclosure by Kobayashi et al (i.e., the claimed invention excludes the soaking step).

It is important to note that the Examiner asserts that the soaking process disclosed by Kobayashi et al is at 100°C for 10-15 minutes (March 22, 2004 Office Action, page 3, line 4); however, as evidenced by the English translation at page 5, lines 5-7 these conditions correspond to the steaming process. In regard to the soaking process, the Examiner's attention is directed to the English translation at page 5, lines 1-4, which specifies that the soaking was at 20°C for 1 hour. As noted above, it is *this soaking step* that the present invention excludes.

The standard for determining anticipation requires that the reference "must teach every element of the claim" (MPEP §2131). Therefore, the absence of any disclosure or suggestion in Kobayashi et al of the omission of the soaking step would necessarily make these references fail to anticipate the present invention.

Applicants submit that the present invention is not even obvious in view of the disclosure of Kobayashi et al, even when combined disclosure of Miyagawa et al.

MPEP §2142 states: "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation... to modify the reference... Second, there must be a reasonable expectation of success. Finally, the prior art reference... must teach or suggest all the claim limitations." In the present case, there can be no reasonable basis to conclude that Kobayashi et al, even when combined disclosure of Miyagawa et al, suggest or motivate that artisan to modify the procedure of Kobayashi et al to omit the soaking step (a required element in Kobayashi et al).

In fact, Applicants note that MPEP §2141.02 states: "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the

claimed invention.” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Kobayashi et al disclose that the soaking step is *required* whereas in the presently claimed invention the soaking step is *excluded* by proviso. Miyagawa et al fails to compensate for this deficiency in the disclosure of Kobayashi et al as Miyagawa et al discloses the need for a preliminary water absorption step (i.e., a soaking step; see column 3, lines 7-8, column 50, lines 50-51, column 7, line 65, and column 8, lines 27-29). Therefore, Applicants submit that the present invention is not obvious in view of the disclosure of Kobayashi et al, even when combined disclosure of Miyagawa et al.

In view of the foregoing, Applicants request withdrawal of the rejections over Kobayashi et al and Miyagawa et al.

The rejection of Claims 5, 6, 11, 18, and 19 under 35 U.S.C. §112, second paragraph, is obviated in part by amendment and traversed in part.

In regard to the Examiner’s rejection of Claims 11, 18, and 19, Applicants have amended these claims to clearly define the claimed invention. Claim 11 has been amended to ensure that proper antecedent basis is present. Claims 18 and 19 have been amended as suggested by the Examiner to replace “A cooked rice type” with “A cooked rice product.” Claim 19 has also been amended to specify that the rice product previously denoted “dry curry” is “dry curry rice.” Applicants note that this amendment is supported by the corresponding claim and the specification as originally filed, for example at page 3, lines 3-7, page 7, lines 17-23, and page 8, lines 3-8.

Turning to the Examiner’s rejection of Claims 5 and 6 based on recitation of the terms “wash rice type,” “wash-free,” and “wash-free milled rice,” Applicants wish to remind

the Examiner that: “Applicants are their own lexicographer” (MPEP §2173.01). MPEP §2173.01 also states that Applicants “can define in the claims what they regard as their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art.” Further, definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made (MPEP §2173.02).

Applicants wish to draw the Examiner’s attention to the definitions of the objected to terms in the specification at page 2, lines 18-19 and page 4, lines 13-15. In view of the above, Applicants submit that the meaning of the terms “wash rice type,” “wash-free,” and “wash-free milled rice” would be clearly understood by the artisan. Applicants further submit that such a meaning is not “contrary to accepted meanings in the art.” Accordingly, Applicants submit that this term is definite within the context of 35 U.S.C. §112, second paragraph.

Withdrawal of this ground of rejection is requested.

Applicants submit that the present application is now in condition for allowance.

Early notification of such action is earnestly solicited.

Respectfully submitted,

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